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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/870,342

05/29/2001

I-Wen Winnie Tsou

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12/19/2005

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

EXAMINER

BEKERMANN, MICHAEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 12/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/870,342	TSOU ET AL.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/18/2001</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 112 on page 8 line 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 102, 116, 300, 314, 320, and 400. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted

after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 29-38 have been renumbered 28-37. Examiner considers claims 29-31 to now depend from claim 28, and not claim 29. Examiner considers claims 33-35 to now depend from claim 32, and not claim 33. Examiner considers claim 36 to now depend from claim 35, and not 36. Examiner requests for applicant to make these corrections in the next reply.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 recites the limitations "said instant messaging server" and "said instant messaging service". There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-25, 27-29, and 32-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitsuoka (U.S. Pub No. 2002/0026355). Mitsuoka teaches a system and method for real-time instant presence with advertisement that includes all of the limitations recited in the above claims.

Regarding claims 1-4, Mitsuoka teaches storing business information identifying said business, retrieving said business information, and transmitting the business information as presence information to a wireless device of an instant messaging user (Paragraphs 0016-0017). The presence information is stored in the wireless device

without requiring manual entry actions (Paragraph 0063). The retrieving of said presence information is in response to a single action of clicking a button (Paragraph 0023).

Regarding claim 5, Mitsuoka teaches communication with a wireless signal when the user device is in range inside an outlet (Paragraph 0063).

Regarding claims 6 and 7, Mitsuoka teaches the business information as being the name of said business (Figure 10a). Since location information for claim 6 is not required, nothing is required in claim 7.

Regarding claims 8-11, Mitsuoka teaches one or more instant messaging users having created an instant messaging address list containing the identity of the first instant messaging user and capable of receiving presence information from the first user (Paragraph 0126). The device in which the instant messaging client is installed is inherent. The subscription to an instant messaging service and the instant messaging server are also both inherent.

Regarding claims 12-14, Mitsuoka teaches the displaying of a selectable icon that can be selected to show text that represents further business information (Figures 12a-12c).

Regarding claims 15-19, Mitsuoka teaches the transmitting of a user profile (containing contact information) to the user DB (the user database is apart of an awareness server of which the business system is also apart) (Paragraphs 0134 and 0135). The act of explicit enablement is satisfied through the registering process.

Presence information is also sent through the instant messaging server (Paragraphs 0136 and 0137).

Regarding claim 20, the ability to display presence information on the wireless device that sets the presence information is an inherent feature.

Regarding claims 21-24, Mitsuoka teaches a storage component for storing business advertising information (the icon is considered to be an advertisement for the business) (Figure 12a and Paragraph 0062), and a business client device that comprises a wireless communication component (Paragraphs 0062 and 0063), a transmitting component (Paragraphs 0062 and 0063), a receiving component for receiving a user profile (Paragraph 0134), and a user database component (Paragraph 0135). The user profile is sent after the user registers (or agrees).

Regarding claims 25 and 27, Mitsuoka teaches a statistics component to receive and store statistics reports on user activity, the statistics reports (the database display is a report) comprising information for business analysis and measurement of marketing success (Paragraph 0202 and Figure 4).

Regarding claims 28 and 29, Mitsuoka teaches the sending of presence information to a first instant messaging user and to other instant messaging users that have the first instant messaging user on an address list (Paragraphs 0016-0018 and 0026-0027). Mitsuoka also teaches the displaying of said presence information, the presence information including a link to advertisements for a business and including a short text message (Figures 12a-12c).

Regarding claims 32-36, Mitsuoka teaches a first instant messaging user wireless device (Paragraphs 0016 and 0017), a device at a business for receiving real time presence information and for sending business information (Paragraphs 0062 and 0063), and one or more additional instant messaging devices that have address lists containing the identity of the first user (Paragraph 0127) and receive presence information from the first instant messaging user (Paragraph 0018). An instant messaging server is inherent in the system, and it is inherent that when presence information is sent between two users, it will go through the server first. The awareness server has a user database and an http server to communicate via the Internet (Paragraph 0134). The business device includes a statistics component whereby statistics are sent from a database to the business database (Paragraph 0202).

Regarding claim 37, Mitsuoka teaches an instant messaging user as being a member of other users' address lists (Paragraph 0127), the transmittal of presence information to an instant messaging server (An instant messaging server is inherent in the system, and it is inherent that when presence information is sent between two users, it will go through the server first) (Paragraph 0018), receiving a selection action from the first instant messaging user that enables transmitting of a user profile (selection action being the registration) (Paragraph 0136), and transmitting the user profile to the system (Paragraph 0135).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuoka (U.S. Pub No. 2002/0026355).**

Regarding claim 26, Mitsuoka doesn't teach statistics reports as being printed.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to print a hard copy of such database reports. This way, hard copy records may be kept to prevent loss by malfunction.

10. **Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsuoka (U.S. Pub No. 2002/0026355) in view of Otani (U.S. Pub No. 2002/0065718).**

Regarding claims 30 and 31, Mitsuoka doesn't specify dynamic updates with additional promotions that link instant message users to a webpage. Otani teaches a user presence that shows a dated advertisement with a link to the homepage (Figures 12a and 12b). Due to the advertisement being dated, dynamic updating of the advertisement must be inherent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include dated advertisements and links to the business homepage in the system of Mitsuoka. This would allow for greater advertising flexibility and depth.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art with respect to advertising systems that make use of instant messaging programs:

U.S. Patent No. 6,968,179 to De Vries (Beginning at Column 11, Line 40)

U.S. Pub No. 2002/0164962 to Mankins (Paragraph 0311)

U.S. Pub No. 2001/0047294 to Rothschild (Paragraph 0017)

U.S. Pub No. 2002/0087631 to Sharma (Paragraph 0013)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JEFFREY D. CARLSON
PRIMARY EXAMINER